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Paper No. 6

IP Department
Schnader Harrison Segal & Lewis
36th Floor
1600 Market Street
Philadelphia, PA 19103

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OFFICE OF PETITIONS

In re Application of
Nakamaru et al.
Application No. 10/045,848
Filed: November 7, 2001
Attorney Docket No. 1315-01

DECISION ON PETITION

This is a decision on the renewed petition filed June 24, 2002, requesting, in effect, that pages 2, 3, 13, 17, and 19 filed on April 11, 2002, be entered as part of the original disclosure.

The petition is **dismissed**.

The application was filed on November 7, 2001. On March 4, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of November 7, 2001, and advising applicants that pages 2, 3, 13, 17, and 19 appeared to have been omitted.

Petitioner alleges that pages 2, 3, 13, 17, and 19 were filed with the original application.

All the evidence present in the file has been carefully considered, but is not persuasive that pages 2, 3, 13, 17, and 19 were submitted with the original application.

The last portion of MPEP 513 states,

Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application) . . . The Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt . . .).

MPEP 503 states (emphasis added),

The identifying data on the postcard should include:

- (A) applicant's name(s);
- (B) title of invention;
- (C) **number of pages of specification, claims (for nonprovisional applications), and sheets of drawing;**
- (D) whether oath or declaration is included;
- (E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and/or provisional application cover sheet); and
- (F) amount and manner of paying the fee.

A return postcard should be attached to each patent application for which a receipt is desired.

It is important that the return postcard itemize all of the components of the application. **If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). . . .**

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. **The postcard should also identify the type of paper being filed**, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., **and the number of pages being submitted**. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., **the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application)**.

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

While petitioner apparently believes that the missing pages were filed on November 7, 2001, the file of application No. 10 045,848 shows that the pages were not received, since no such papers are present in the file. An applicant alleging that a paper was filed in the USPTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence. Petitioner has submitted declarations from two individuals attesting that the papers were present. Declarations alone, without corroborating evidence, are normally insufficient to establish a filing date or to establish the contents of an application. In this case, the evidence submitted is not

¹ *Federal Register* at 48 Fed. Reg. 27266 (January 21, 1983) (and in the Patent and Trademark Office *Official Gazette* at 1027, *Off. Gaz. Pat. Office* 9 (February 1, 1983)) and the court of appeals commented that he found the idea of using a declaration or affidavit to establish a date of filing of an acceptable receipt for express delivery of the assignment of filing dates to the risk of deception. Reply, *The Inventor Declaration*, 1027, *Off. Gaz. Pat. Office* 9. (Usually intended to help explain activities which can be supported by exhibits. For example, if the express delivery label on a package was not clearly readable, applicant's copy of the "Express Mail" mailing label could accompany a declaration of service as the basis for granting a filing date.)

² *Hengsbahm v. Lehman*, 903 F.2d 849, 852, 859, 217 USPQ 2d 1668 (1990) (hereinafter "the *Hengsbahm* affidavit"). The affidavit recites that the inventor filed a declaration of the filing date of the application, and copies of two pages of record from the application, and that the Commissioner finally accepted plaintiff's petition for a filing date on the actual date of the express delivery of the package. Moreover, he would have had an Express Mail receipt showing the actual date of mailing, and that the package was delivered to the inventor's office on the actual date.

more probative of what was actually received by the Office than the file wrapper which contains the papers received and is an official government record prepared and maintained by disinterested USPTO employees as a part of their customary and usual duties.

Since applicants have not filed a petition under 37 CFR 1.182 requesting a filing date of April 11, 2002, the date the missing pages were filed, as the filing date, the pages filed on April 11, 2002, will not be entered. Although the current petition is labeled "Petition Under 37 C.F.R. § 1.182," petitioner does not request a filing date of April 11, 2002, and therefore the filing date will remain November 7, 2001, and the missing drawings will not be entered.

An amendment to the specification deleting references to the missing pages should be filed prior to the first USPTO action in order to avoid further delays in the examination of the application.

If petitioner desires for the examiner to consider pages which were not submitted as part of the original disclosure, then petitioner may seek to submit some or all of those pages as an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter. See MPEP 608.02(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By facsimile: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, VA 22202

If a request of reconsideration, or petition under 37 CFR 1.182, is not filed within two months, the file will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of November 7, 2001, using only the application papers filed on that date.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

The materials plaintiff gathered together included an envelope containing an Express Mail label that is undated and bears no evidence of any U.S. Postal Service postage. No evidence was found to indicate the Patent and Trademark Office is corroborated by anything outside the office of the Commissioner for Patents that the express label is a registered trademark. Plaintiff's trademarks that these circumstances did not establish the express label as a registered trademark are denied.

The decision was for the Commissioner to issue a certificate of mailing to the Office of the Commissioner for Patents. The Commissioner's decision was affirmed in the Court of Appeals for the Federal Circuit in the case of *Plaintiff v. USPTO*, without opinion, 951 F.2d 1169, 14 USPQ2d 1272.